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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants : | Ford <i>et al</i>   | ) Group Art Unit: 2171 |
|              |   | )                      |
| Appl. No. :  | 09/528,127  | )                      |
|              |   | )                      |
| Filed :      | March 17, 2000  | )                      |
|              |   | )                      |
| For :        | System and Method for<br>Presenting Multiple-Category<br>Search Results | )                      |
|              |   | )                      |
| Examiner :   | Thuy Pardo  | )                      |

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SUPPLEMENTAL APPEAL BRIEF  
PURSUANT TO 37 C.F.R. § 1.192

Board of Patent Appeals and Interferences  
Washington, D.C. 20231

Dear Sir:

This Supplemental Appeal brief is being submitted in accordance with 37 C.F.R. 1.193(b)(2)(ii) to address the new grounds for rejection raised in the Office Action mailed on May 23, 2002. Appellants are concurrently submitting a Request for Reinstatement of Appeal.

Appellants hereby incorporate by reference the following sections from their original Appeal Brief:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of the Claims
- IV. Status of Amendments
- V. Summary of the Invention
- VII. Grouping of Claims
- VIII. Argument (description of the Schultz only)
- Appendix

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**A. NEW BASIS FOR REJECTION**

In the Office Action dated May 23, 2002, the Examiner withdrew the final rejection of Claims 1-33 over Schultz and Ballard. In addition, the Examiner rejected Claim 1-21 on obviousness grounds over Schultz in view of the Text Search and Retrieval Training Manual for the Automated Patent System (APS), dated December 3, 1991 (hereinafter "APS"). Although the Examiner did not provide any basis for rejecting Claims 22-33, she indicated on the Office Action Summary sheet that Claims 1-33 are rejected. Appellants will therefore assume, for purposes of this supplemental brief, that Claims 22-33 stand rejected on obviousness grounds over Schultz and APS.

**B. WITHDRAWAL OF CLAIMS**

Appellants hereby withdraw from the present appeal all Group 1 claims except for Claim 6. The claims that remain in the appeal are thus grouped as follows:

GROUP 1: Claim 6. This claim is directed generally to the subject matter identified in the original Appeal Brief (see description of Group 1 in original Appeal Brief), but further specifies how the category significance level is determined for at least one of the categories. Specifically, Claim 6 further specifies that the process of generating the category significance levels comprises (a) determining, for at least one category of the plurality of the categories, a number of items that satisfy the query; and (b) generating for the category a score which is based on at least said number of items that satisfy the query relative to a total number of items within the category. See present application at, e.g., page 3, lines 4-8.

GROUP 2: Claims 3-5, 14, 15, 18, 19 and 22-33. As set forth in the original Appeal Brief, these claims require that the categories be presented to the user in an order that is dependent upon the popularity levels of located items. Some of these claims further specify the types of user actions monitored to determine such item popularity levels.

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### **C. ISSUES PRESENTED ON APPEAL**

The following issue is presented:

Whether the claims of Groups 1 and 2, as set forth above, are properly rejected under 35 U.S.C. § 103 as unpatentable over Schultz (U.S. Patent No. 5,640,553) in view of APS.

### **D. ARGUMENT**

#### **1. THE GROUP 2 CLAIMS ARE PATENTABLY SEPARATE FROM THE CLAIMS OF GROUP 1**

As set forth above, the claims of Group 2 require that the categories be presented to the user in an order that is dependent upon the popularity levels of located items (unlike the single claim of Group 1). This feature of the Group 2 claims provides a separate basis for patentability.

#### **2. DISCUSSION OF REFERENCES RELIED ON BY EXAMINER**

In rejecting the claims, the Examiner relied on the following references:

##### **Schultz**

The Schultz patent discloses various features that may be incorporated into a search engine system. The portion of Schultz relied on by the Examiner discloses a process in which relevance scores are generated for each of the items (document files) located by a search, and are used to determine an order in which these files are to be presented to the user/searcher. The relevance score for each file is based in part on the relative proximity within the file of the query terms.

Significantly, Schultz does not disclose or suggest ranking or scoring the categories of the search result items (document files). Schultz also fails to disclose or suggest a process for selecting an order in which to present such categories to users.

##### **APS**

The portion of ASP provided to Appellants by the Examiner consists of page 5-17 and page 5-18.<sup>1</sup> These pages appear to describe a user interface through which a user can search a

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<sup>1</sup> Although no portion of APS was enclosed with the May 23, 2002 Office Action or listed on the attached Notice of References Cited, the Examiner subsequently sent these pages of APS to Appellants by facsimile.

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database of patents. In one view, which is shown at the middle of page 5-18, a list of classification codes is presented together with the numbers of matching patents falling within each classification. This list is ordered from highest to lowest number of matching patents.

## 2. DISCUSSION OF THE ISSUES ON APPEAL

For the reasons set forth below, Appellants respectfully submit that the teachings of Schultz and APS do not render the present invention obvious.

### a. The references relied on by the Examiner do not disclose or suggest every limitation of the single claim in Group 1

Group 1 consists of dependent Claim 6 which recites, among other things, “generating for the category a score which is based on at least said number of items that satisfy the query *relative to a total number of items within the category*” (emphasis added). The Examiner appears to take the position that this method for determining a category significance level is disclosed in APS. Appellants respectfully disagree.

APS merely teaches the ordering of the categories (patent classifications) based on the number of matches within each such category, without regard to the total number of items (patents) within that category. A significant deficiency with this method is that the ordering may not accurately reflect the relevance or significance of each category to the search query. For instance, the number of matches in category A may be higher than the number of matches in category B merely because category A is much larger (has more items) than category B. By taking the total number of items into consideration in determining the category significance level, the method of Claim 6 provides a significantly better measure of how relevant the particular category is to the search query.

Because this feature of Appellants invention is not disclosed or suggested by either Schultz or APS, the rejection of Claim 6 is improper.

### b. The references relied upon by the Examiner do not disclose or suggest every limitation of any claim in Group 2.

As set forth in the original Appeal Brief, all of the claims in Group 2 require that the presentation order of the categories be dependent upon the popularity levels of located items. For instance, independent Claim 29 recites “selecting an order in which to present the multiple

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categories to the user such that the order is dependent upon the popularity levels of the responsive items.” As set forth in Appellants’ original Appeal Brief, the term “popularity” is defined in Webster’s New Encyclopedic Dictionary (1993) as follows:

*Popularity: the quality or state of being popular*

*Popular: (1) of, relating to, or coming from the whole body of people*

In connection with this aspect of the Group 2 claims, the Examiner asserts that Schultz teaches determining item popularity scores for the corresponding set of items that satisfy the query at Figure 4A (which lists the number if items found), and at column 4, lines 8, 9 and 30-33. See Office Action dated May 23, 2002 at section 10. Appellants respectfully disagree. Nothing in the cited portions of Schultz suggests determining or using popularity levels of the located items. In this regard, the display of the number of items found (Figure 4A) is not an indication of the “popularity levels” of these items. The item scores 342 (Figure 4A) similarly are not measures of the respective item popularity levels, but rather are based on a degree to which the query matches or corresponds to each located item. See Schultz at col. 6, lines 62-65 and col. 13, lines 35-52.

The Examiner additionally asserts that APS teaches the use of item popularity scores to determine the category significance level for a category. Office Action dated May 23, 2002 at section 10. Appellants respectfully disagree. As explained above, APS discloses ordering the categories (patent classifications) based solely on the numbers of matches found within such categories. There is absolutely no suggestion in APS to take popularity levels of the located items into consideration.

Because neither Schultz nor APS teaches or suggests presenting the responsive item categories in an order which is dependent upon the popularity levels of located items, the rejection of the Group 2 claims is improper.

**c. Schultz and APS are not properly combinable.**

Appellants further respectfully submit that in rejecting the claims of Groups 1 and 2, the Examiner has failed to identify a sufficient suggestion or motivation to combine or modify

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Schultz and APS. Appellants further submit that no such suggestion or motivation exists within these references.

As set forth in MPEP 2143.01, in order to establish obviousness based on a combination of references, the prior art must suggest the desirability of the claimed combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (emphasis original).

In the present case, neither reference suggests the desirability of presenting the responsive categories in an order which is dependent upon the category significance criteria set forth in the claims of Groups 1 and 2. As explained in the present application, an important benefit of this method of presenting the categories is that it “increases the likelihood that the categories that are of most interest to the user will be presented near the top of the search results listing, or otherwise called to the attention of the user.” See page 3, lines 14-16 of the present application.

The only disclosure in the applied references involving the ordering of the responsive categories involves ordering the categories based solely on the number of matches found in each category (see APS). As explained above, the number of matches found within a category does not, by itself, accurately indicate the level of significance of the category to the search query. For example, the number of matches found within a given category may be relatively high merely because the total number of items in that category is relatively high.

The Examiner does not address this issue in the Office Action, and does not identify a suggestion or motivation within the prior art to combine Schultz and APS. Rather, the Examiner merely makes the conclusory assertion that it would have been obvious “to add the feature of APS to the system of Schultz as an efficient means to bring to clients’ attentions of all related items that satisfy the query from different categories.” This assertion appears to be based on Applicants’ disclosure, and not on the cited references.

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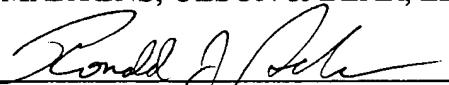
**E. CONCLUSION**

For the reasons set forth above, Appellants submit that the obviousness rejection of Claims 3-6, 14, 15, 18, 19 and 22-33 is improper, and request that the rejection be reversed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7-19-02

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